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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,842	03/23/2000	Michael Ficco	PD-990219	2213

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HUGHES ELECTRONICS CORPORATION
PATENT DOCKET ADMINISTRATION RE/R11/A109
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EXAMINER	
KOENIG, ANDREW Y	

ART UNIT	PAPER NUMBER
2611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/533,842	Applicant(s) FICCO, MICHAEL	
	Examiner Andrew Y Koenig	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) *14-20 and 36-39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 21-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: Claims 7-9, 12, and 29-35 correspond to figures 1 and 2, wherein the invention is directed to inserting/replacing the commercials in their entirety.

Group II: Claims 14-20 and 36-39 correspond to figure 3, wherein the invention is directed to the modification of the commercial itself.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6, 10, 11, 13, and 21-28 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Craig Plastrik of record on 05 March 2004 a provisional election was made to prosecute the invention of group I (the insertion/replacement of commercials in their entirety) of claims 7-9, 12, and 29-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-20 and 36-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-13, 21, 22, 25, 26, and 28 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,002,393 to Hite et al.

Regarding claim 1, Hite teaches instructions sent to the user (col. 4, ll. 10-14). which reads on a selection factor for a user based on collected information on the user

(col. 3, ll. 17-29), which then adapts the broadcast content to the selection factor (col. 4, ll. 40-48; col. 5, ll. 7-14).

Regarding claim 2, Hite teaches a media origination facility synchronizing the adapted broadcast with other content (fig. 3, label 340, col. 8-9, ll. 60-1).

Regarding claim 3, Hite teaches gathering information from the user, and using the information to generate the instructions (claimed selection factor) (col. 2, ll. 44-65, col. 3, ll. 17-28).

Regarding claim 4, Hite teaches tracking content selected by the recipient, by gathering viewer reactions (col. 3, ll. 17-28), and using the information to generate additional selection factors such as relevant commercials and detailed information about the same product or service.

Regarding claim 5, Hite teaches inputting information from a database (col. 7, ll. 7-35).

Regarding claim 6, Hite teaches inputting information from the recipient via a user interface device (col. 3, ll. 17-29, col. 10, ll. 56-59).

Regarding claim 7, Hite teaches inserting a commercial by tuning to the desired frequency (col. 4, ll. 10-13; col. 4, ll. 40-48) and by storing commercials in local storage (col. 5, ll. 7-17), which equates to selecting a content segment.

Regarding claim 8, Hite teaches storing selectable content segments in a local device (col. 5, ll. 7-17; col. 9, ll. 25-33).

Regarding claim 9, Hite teaches transmitting the commercials to the local device (col. 5, ll. 7-17).

Regarding claim 10, Hite teaches showing the entire commercial (col. 11, ll. 58-60), which equates to selecting an entire broadcast content.

Regarding claim 11, Hite teaches retrieving commercials from storage for display (col. 12, ll. 3-27), which reads on "assembling content from a plurality of broadcast content segments according to the selection factor"

Regarding claim 12, Hite teaches selecting the programs using the commercial processor (578), which selects the appropriate commercials for display (col. 4, ll. 36-39).

Regarding claim 13, Hite teaches selecting the programs using the commercial processor (578), which selects the appropriate commercials for display (col. 4, ll. 36-39).

Regarding claim 21, Hite teaches a recipient as an individual (abstract, col. 1, ll. 7-10).

Regarding claim 22, Hite teaches gathering the identity of the individual (col. 6, ll. 9-13).

Regarding claim 25, Hite teaches adjusting the selection factor to accommodate changes (col. 3, ll. 17-29).

Regarding claim 26, Hite teaches a consumer database, which has a selection factor including a plurality of components, each categorizes a user based on needs and wants (col. 7, ll. 20-26), and using at least one category to generate a selection factor, using a programming database (col. 7, ll. 36-41).

Regarding claim 28, Hite teaches commercials, which equate to advertisements.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,002,393 to Hite et al. in view of U.S. Patent 6,530,083 to Liebenow.

Regarding claim 23, Hite teaches is silent on a group of individuals. Liebenow teaches individual profiles for a plurality of users and merging the profiles when a group is present (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite by using a profile for a group as taught by Liebenow in order to provide the optimum settings for the group.

Regarding claim 24, Hite is silent on gathering the identity of the group. Liebenow teaches identifying all the users to identify the group (col. 2, ll. 50-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite by identifying the group as taught by Liebenow in order to provide the optimum settings for the group and enhance the viewing experience.

7. Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,002,393 to Hite et al.

Regarding claim 27, Hite is silent on data mining. Official Notice is taken that data mining is well known in the art. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Hite by data mining in order to identify user patterns thereby more efficiently targeting programming to users.

8. Claims 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,002,393 to Hite et al. in view of U.S. Patent 5,600,366 to Schulman.

Regarding claim 29, Hite teaches a local storage device (fig. 4, label 551), a commercial processor operably connected to a broadcast feed, storage device, and input device that reads on a selector (col. 4, ll. 49-56; fig. 5, label 578, fig. 6); wherein the selector selects programming and commercials from storage; but is silent on a synchronization signal detector. Schulman teaches a cue detector (col. 7, ll. 23-33), which equates to a synchronization signal detector. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite by using a cue detector as taught by Schulman in order to seamlessly replace commercials in programming.

Regarding claim 30, Hite teaches a commercial processor (578), which selects the appropriate commercials for display (col. 4, ll. 36-39), thereby teaching selecting from the broadcast and storage, however, Hite is silent on the synchronization detector connected to the broadcast feed and the selector. Schulman teaches a cue detector, which equates to the synchronization signal detector operably coupled to the broadcast feed and selector (fig. 7, col. 7, ll. 23-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite by coupling

the detector to the broadcast feed and the selector as taught by Schulman in order to receive and store programming while facilitating commercial insertions.

Regarding claim 31, Hite teaches gathering information from the user, and using the information to generate the instructions (claimed selection factor) (col. 2, ll. 44-65, col. 3, ll. 17-28).

Regarding claim 32, Hite teaches inputting information from a database (col. 7, ll. 7-35).

Regarding claim 33, Hite teaches tracking content selected by the recipient, by gathering viewer reactions (col. 3, ll. 17-28), and using the information to generate additional selection factors such as relevant commercials and detailed information about the same product or service.

Regarding claim 34, Hite teaches inputting information from the recipient via a user interface device, wherein the selection is based on the user input (col. 3, ll. 17-29, col. 10, ll. 56-59).

Regarding claim 35, Hite teaches commercials, which equate to advertisements.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. U.S. Patent 5,758,257 to Herz et al. teaches clustering of profiles, profile management.

11. U.S. Patent 6,029,045 to Picco et al. teaches a local storage device for commercial insertion for a satellite system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ayk

HAITRAN
PATENT EXAMINER